

REMARKS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-3, 5-10, and 12 are pending in this application, Claims 1, 5, 6, 8, and 12 having been currently amended; and Claim 11 having been canceled without prejudice or disclaimer. Support for amended Claims 1, 5, 6, 8, and 12 can be found, for example, in the original claims, drawings, and the specification as originally filed. No new matter has been added.

In the outstanding Office Action, Claims 8-10 were rejected under 35 U.S.C. § 101; Claims 1-3 and 5-12 were rejected under 35 U.S.C. § 112, second paragraph; Claims 1-3, 5-7, and 12 were rejected under 35 U.S.C. § 102(b) as anticipated by Rodgers et al. (U.S. Patent Publication No. 2002/0026478; hereinafter “Rodgers”); and Claims 1-3 and 5-12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Nakano et al. (U.S. Patent Publication No. 2003/0152222; hereinafter “Nakano”) in view of Danneels et al. (U.S. Patent No. 6,272,472; hereinafter “Danneels”), Nakano et al. (U.S. Patent Publication No. 2004/0243814; hereinafter “Nakano II”); and Matsuyama et al. (U.S. Patent Publication No. 2002/0026581; hereinafter “Matsuyama”).

In response to the rejection of Claims 8-10 under 35 U.S.C. § 101, Applicants initially note that Claims 9-10 were improperly rejected under 35 U.S.C. § 101 because Claims 9 and 10 do not depend on Claim 8 as asserted at page 5 of the outstanding Office Action. Rather, Claims 9 and 10 are directed to a computer-readable storage medium and are dependent on independent Claim 2.

With respect to independent Claim 8, Applicants have amended Claim 8 to more clearly be directed towards statutory subject matter. Applicants respectfully submit that the method recited in amended Claim 8 is tied to a particular machine or apparatus, as Claim 8

recites that the information processing method is implemented by an information processing apparatus, and recites that a processor in the information processing apparatus performs an authentication process with the first execution file. Thus, the method recited in Claim 8 is tied to a particular apparatus as the claim positively recites the machine that performs the method steps.

Accordingly, Applicants respectfully request that the rejection of Claims 8-10 under 35 U.S.C. § 101 be withdrawn.

In regard to the rejection of Claims 1-3 and 5-12 under 35 U.S.C. § 112, second paragraph, Applicants have canceled Claim 11 rendering the rejection of Claim 11 moot. In regard to the rejection of Claim 12, page 6 of the outstanding Office Action states “‘computer-readable storage medium’ in the preamble of the claim. However, the limitations following the preamble are further describing an apparatus and functions of the apparatus. The structure or mechanics of the claimed medium can not be found.” Applicants respectfully disagree. Applicants’ preamble of Claim 12 recites a computer-readable storage medium and the body of Claim 12 further describes files which are stored on the computer-readable storage medium. MPEP 2106.01 states that “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” Thus, Applicants respectfully submit that Claim 12 does not describe an apparatus as asserted at page 6 of the outstanding Office Action, and submit that Claim 12 sufficiently describes the information stored on the computer-readable storage medium. Thus, Applicants respectfully request that the rejection of Claim 12 be withdrawn.

In regard to the rejection of Claim 5, page 7 of the outstanding Office Action states “[a]pplicant recites ‘unique key information obtained from said first execution file’ at line 9

of the claim. The previous act of obtaining unique key information can not be found.”

Applicants have amended Claim 5 to recite “generating encryption key information based on unique key information that is obtained from said first execution file.” In addition, Applicants respectfully submit that it is not required that the previous act of obtaining unique key information explicitly be recited in the claim, as it is clear from the claim language that the unique key information is obtained from the first execution file. Thus, Applicants respectfully request that the rejection of Claim 5 on page 7 of the outstanding Office Action be withdrawn.

In regard to all other rejections of the claims under 35 U.S.C. § 112 not discussed above, Applicants have amended Claims 1-3, 5, and 8-10 to correct the informalities noted in the outstanding Office Action.

Accordingly, Applicants respectfully request that the rejection of Claims 1-3 and 5-12 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In response to the rejection of Claims 1-3, 5-7, and 12 under 35 U.S.C. § 102(b) as anticipated by Rodgers, Applicants respectfully submit that amended independent Claim 1 recites novel features clearly not taught or rendered obvious by the applied art reference.

Amended independent Claim 1 is directed to a computer-readable storage medium including, *inter alia*:

...a first execution file recorded on said computer-readable storage medium using a copy protection mechanism, said first execution file including

instructions for performing an authentication process with a second execution file,

instructions for obtaining unique key information unique to said first execution file, and

instructions for transmitting said unique key information to said second execution file,

wherein the instructions for performing, instructions for obtaining, and instructions for transmitting in said first execution file are executed by an information processing apparatus including a processor, when said computer-readable storage medium is inserted into said information processing apparatus, and said second execution file generates a content key from said transmitted unique key information, decrypts encrypted content using the content key, and reproduces the decrypted content, and

wherein said encrypted content is recorded on said computer-readable storage medium and said unique key information is configured to encrypt encryption key information which is used for encrypting digital signature information that has previously been attached to said encrypted content, and said instructions for transmitting cause said encrypted content to be transmitted to said second execution file based on said digital signature information.

Independent Claims 5 and 8 recite substantially similar features as independent Claim

1. Thus, the arguments presented with respect to independent Claim 1 are also applicable to independent Claims 5 and 8.

Page 8 of the outstanding Office Action asserts that Rodgers discloses each and every feature of Applicants' independent Claims 1, 5, and 8, because paragraph [0170] of Rodgers describes a computer-readable medium comprising program code. Applicants respectfully disagree. Rodgers is directed to linked multi-user groups of shared software applications.¹

Paragraph [0170] of Rodgers states:

It should be appreciated that any single component or collection of multiple components of the computer system that perform the functions described above can be generically considered as one or more controllers that control the above-discussed functions. The one or more controllers can be implemented in numerous ways, such as with dedicated hardware, or using a processor that is programmed using microcode or software to perform the functions recited above. In this respect, it should be appreciated that one implementation of the present invention comprises at least one computer readable medium (e.g., a computer memory, a floppy disk, a compact disk, a tape, etc.) encoded with a program that, when

¹ See Rodgers at paragraph [0002].

executed on a processor, performs the above-discussed functions of the present invention. The computer readable medium can be transportable such that the program stored thereon can be loaded onto any computer system resource to implement the aspects of the present invention discussed above. In addition, it should be appreciated that the reference to a computer program that, when executed, performs the above-discussed functions is not limited to an application program running on application space on any computer. Rather, the term computer program is used here in a generic sense to reference any type of computer code (e.g., software or microcode) that can be employed to program a processor to implement the above-discussed aspects of the present invention.

Thus, Rodgers merely describes that one implementation of the invention comprises at least one computer readable medium encoded with a program that, when executed on a processor, performs the functions of the invention described in Rodgers. That is, Rodgers broadly describes a computer readable medium with program code, but Rodgers does not describe a computer-readable storage medium including a first execution file recorded on the computer-readable storage medium using a copy protection mechanism, the first execution file including: instructions for performing an authentication process with a second execution file, instructions for obtaining unique key information unique to said first execution file, and instructions for transmitting said unique key information to said second execution file.

Thus, Rodgers fails to teach or suggest each and every feature recited in Applicants' independent Claims 1, 5, and 8. MPEP 2131 states that "A claim is anticipated *only if each and every* element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "*All words in a claim must be considered* in judging the patentability of that claim against the prior art." The outstanding Office Action did not consider all of the words in Claims 1, 5, and 8 when determining patentability.

Accordingly, Applicants respectfully request that the rejection of Claims 1-3, 5-7, and 12 under 35 U.S.C. § 102(b) as anticipated by Rodgers be withdrawn.

In response to the rejection of Claims 1-3 and 5-12 under 35 U.S.C. § 103(a) as unpatentable over Nakano in view of Danneels, Nakano II, and Matsuyama, Applicants respectfully request reconsideration of the rejection and traverse the rejection as discussed next.

Page 12 of the outstanding Office Action states:

Applicant is reminded that it has been held stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983); *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004); *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01). All the limitations in Claims 1 and 12 are directed to stored data, and are not given patentable weight for the purpose of prior art examination. In Claim 2, limitations following “wherein said second execution file includes...” are not given patentable weight for the purpose of prior art examination. In Claim 5, limitations following “a second execution file for reproducing an encrypted content” are not given patentable weight for the purpose of prior art examination.

First, Applicants note that the *In re Gulack*, *In re Ngai*, and *In re Lowry* cases are cited in MPEP 2106.01 as pertaining to **nonfunctional** descriptive material. MPEP 2106.01 describes that nonfunctional descriptive material includes but is not limited to music, literary works, and a compilation or mere arrangement of data. Applicants’ Claim 1 is not directed to one of these categories of subject matter. MPEP 2106.01 describes that **functional** descriptive material consists of data structures and computer programs which impart functionality when employed as a computer component. Thus, Applicants’ Claim 1 is not directed to a computer-readable storage medium which stores nonfunctional descriptive material, but rather stores **functional** material.

The outstanding Office Action also cites MPEP 2106.01 in support of its assertion that “stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art.” However, MPEP

2106.01 states that when “functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” Also, MPEP 2106.01 deals with determining whether or not subject matter is statutory, it does not give any guidance for determining whether or not certain features are given patentable weight.

Further, Applicants note that the *In re Gulack* decision does not hold that “stored data is not functionally related to the memory in which it is stored and does not distinguish the claimed apparatus, method, and system from the prior art” as asserted in the Office Action. In fact, the *In re Gulack* case does not involve stored data on a memory at all. As explained in Applicants’ previous response, *In re Gulack* relates to descriptive material presented on a substrate, *In re Gulack* is wholly unrelated to the Applicants’ claims as the invention in *In re Gulack* has three elements: 1) a band, ring, or set of concentric rings, 2) a plurality of digits imprinted on the band or ring at regularly spaced intervals; and (3) an algorithm by which the appropriate digits are developed. The nonfunctional descriptive written material distinguished in *In re Gulack* is only deemed nonfunctional as it relates to the patentability of a substrate. Simply stated, this case makes it clear that what is *written* on a *substrate* will not distinguish the invention from the prior art in terms of patentability *of the substrate*. It is unclear why the Official Action cites this case as a first execution file including instructions for performing an authentication process with a second execution file *is not written material*. Applicants’ claimed first execution file including instructions for performing an authentication process with a second execution file is in stark contrast to a mere font of typeface, as discussed in the cited case law. Accordingly, Applicants submit that this rejection is deficient, and should be withdrawn, at least, for this reason alone.

Turning now to the applied references, Applicants respectfully submit that the cited references fail to teach or suggest “said first execution file including instructions for performing an authentication process with a second execution file, instructions for obtaining unique key information unique to said first execution file, and instructions for transmitting said unique key information to said second execution file,” as recited in Claim 1.

Page 11 of the outstanding Office Action asserts that paragraphs [0045], [0046], [0061], and [0076] of Nakano describes “obtaining unique key information unique to said first execution file” and paragraph [0076] of Nakano describes “transmitting said unique key information to said second execution file.” Applicants respectfully disagree.

Paragraph [0076] of Nakano states:

The reference license information computing unit 35 has a computational mechanism that performs the same computation as the license information computing unit 16, to compute reference license information. In detail, the reference license information computing unit 35 acquires the media number recorded in the media number area 21, the encrypted content key recorded in the encrypted content key area 23, and the master key stored in the master key storing unit 31. The reference license information computing unit 35 concatenates the media number, the master key, and the encrypted content key into one bit string. The order of concatenating these data is the same as the order used by the license information computing unit 16. The reference license information computing unit 35 takes this bit string as input, and performs a computation using a hash function such as, SHA-1. As a result, the reference license information computing unit 35 obtains a hash value of 160 bits in length, and sets the hash value as reference license information.

Thus, the above portion merely describes that the encrypted content key is recorded in the encrypted content key area 23. However, the above portion of Nakano does not describe that a first execution file recorded on a computer-readable medium includes instructions for transmitting unique key information, that is unique to the first execution file, to a second

execution file which has been authenticated. Hence, paragraph [0076] of Nakano does not describe transmitting unique key information as asserted in the Office Action.

Applicants respectfully submit that Danneels, Nakano II, and Matsuyama fail to cure any of the above-noted deficiencies of Nakano.

Accordingly, Applicants respectfully request that the rejection of Claims 1-3 and 5-12 under 35 U.S.C. § 103(a) as unpatentable over Nakano in view of Danneels, Nakano II, and Matsuyama be withdrawn.

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 03/06)

Derek P. Benke
Registration No. 56,944